

**REMARKS**

The October 2, 2003 Office Action has been considered; and the amendments above together with the comments that follow are presented in a bona fide effort to completely respond to all issues raised in that Action. Claims 14, 17 and 19 are amended, and new claims 23-32 are presented for examination. As explained below, it is believed that this complete response places the case in condition for allowance. Claims 1-32 are active in this case and are believed to be in condition for allowance. Hence, a prompt favorable reconsideration of the merits of this case is respectfully requested.

Applicant notes with appreciation that the Examiner indicated that claims 14-20 would be allowable if recast in independent form. By amendments above, Applicant has recast claims 14, 17 and 19 in independent form by bodily incorporating the original language of respective parent claims (and intervening claims where appropriate). Hence, claims 14, 17 and 19 have precisely the scope as originally filed and indicated allowable. Each of claims 15, 16, 18 and 20 depend from one of the new independent claims. It is respectfully submitted that claims 14-20 should be ready for allowance, in view of the indication of allowable subject matter in the Office Action.

Claims 1-13, 21 and 22 stand rejected under 35 U.S.C. § 103 as unpatentable (obvious) over US Patent No. 6,366,780 to Obhan in combination with the Lucent/TCS document entitled "Short Messaging," which was submitted in the information disclosure statement. The rejection is respectfully traversed.

The Obhan patent discloses a technique for managing traffic load in a cellular network, in which the network maintains power status data in the VLR, in response to registration activities. The Examiner recognizes that the Obhan system does not provide the mobile station power status

information to an ISP. Clearly, by itself, the Obhan document does not suggest all aspects of any of the rejected claims.

The Examiner asserts that addition of the transmissions to an ISP would have been obvious in view of the disclosure of a mobile activity status tracker and associated services for mobile chat, buddy messaging and the like on pages 66-86 of the "Short Messaging" document, which was submitted in the October 25, 2000 information disclosure statement. It is respectfully submitted that the "Short Messaging" document is not a **prior art reference** with respect to the rejected claims of this application. It should be noted that Applicant's submission of the "Short Messaging" document, in the information disclosure statement, was not an admission against interest that the document was somehow "prior art." To the contrary, with the disclosure statement, Applicant submitted two Rule 131 declarations (one by inventor Bruce Ciotta, and a corroborating one by Keith George) to show an earlier date of invention. It is submitted that the evidence presented in the declarations shows conception of at least as much of the subject matter of the rejected claims as provided by the "Short Message" document prior to the June 21, 2000 effective date of that document, coupled with due diligence from a date prior to the date of the "Short Message" document up to the filing date (July 21, 2000) of the provisional case from which this application claims priority. In view of the earlier date of invention and priority, the June 21, 2000 date of the applied "Short Message" document is later than Applicant's date of invention with respect to subject matter of the rejected claims. The Examiner has not addressed the evidence of earlier invention, therefore it is believed that the evidence is dispositive as to Applicant's prior date of invention with respect to the rejected claims.

Since the secondary "Short Message" document is not a **prior art reference** with respect to the rejected claims of this application, that document can not serve as a basis for a rejection of

the relevant claims. As noted above, the Examiner has already recognized that the Obhan document alone does not meet or suggest all the limitations of any of the rejected claims. It therefore is submitted that claims 1-13, 21 and 22 specify patentable subject matter, the rejection thereof is improper, and the rejection should be withdrawn. Hence, claims 1-13, 21 and 22 should be indicated allowable over the art.

New claims 23-32 also are presented for examination. As noted above, the secondary "Short Message" document is not a **prior art reference** with respect to the rejected claims of this application. The primary document to Obhan does not suggest the methods of these new claims. Independent claim 23 specifies receiving station status signals and sending messages indicating that the mobile station is available or is no longer available, to an ISP system. Independent claim 27 specifies receiving a signal indicating in a change in status of a mobile station with regard to availability, determining from a profile record if notice of the status change should be provided to an ISP, and if so, sending a message indicating the changed status to a system of the ISP. Independent claim 30 specifies a method as might be performed, for example, at a system operated by the ISP. The method of claim 30 includes receiving a signal from a wireless network indicating that a wireless mobile station is available, correlating the mobile station to an on-line customer of the ISP, and sending a message indicating the availability of the mobile station to the on-line customer. The Obhan patent does not suggest communicating mobile station status signals to a system of an ISP. Consequently, Obhan does not disclose or reasonably teach one skilled in the art to implement the steps of independent claims 23, 27 and 30, as noted above. For at least these reasons, it is believed that new claims 23-32 are patentable over the applied documents.

Applicant has noted the Examiner's statement of reasons for allowance with respect to claims 14-20. Entry of that Statement into the record should not be construed as any agreement with or acquiescence by Applicant in the reasoning stated by the Examiner. First, it should be noted that original application claims 14-20 have been indicated as patentable over the art in the first action on the merits, without any art rejection thereof. These claims stand allowed without any specific comments attributable to Applicants, with regard to patentability of the claims over the art. The relevant amendments above only recast selected ones of these claims in independent form without narrowing the scope of any of claims 14-20. Also, in this case, the original independent claims have been pursued without any narrowing amendment. Hence, there has been no surrender of subject matter by amendment, whatsoever. Furthermore, in view of the evidence of a prior date of invention, it is submitted that the "Short Messaging" document is not prior art with respect to claims 14-20, and as such, need not be distinguished by these or any other claims in this case. Under these circumstances, there should be no need for any detailed commentary regarding patentability of claims 14-20, and those claims should be entitled to the broadest scope and the broadest range of equivalents appropriate in light of the language thereof and the supporting description in Applicant's specification.

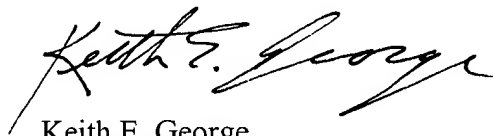
The issues raised in the Action, specifically, the art rejection of claims 1-13, 21 and 22 and the reasons for allowance regarding claims 14-20, are addressed by the remarks above. New claims 23-32 also are believed to be patentable, as outlined above. It is believed that this response overcomes all issues discussed in the Office Action and places this case in condition for immediate allowance.

If any further issue should arise, which may be addressed in an interview or by an Examiner's amendment, it is requested that the Examiner telephone Applicant's representative at the number shown below.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

A handwritten signature in black ink, appearing to read "Keith E. George", written over a horizontal line.

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**Date: November 20, 2003**